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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES LEE HAFNER,
MALISSA WILTSEY O'MARA, and
PAUL STUART WILLIAMSON

Appeal 2015-002200
Application 12/139,565[1]
Technology Center 3600

Before HUBERT C. LORIN, BRUCE T. WIEDER, and
BRADLEY B. BAYAT, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

James Lee Hafner, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–25. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

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[1] The Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 2.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A computer implemented method of generating an energy transaction plan for controlling aspects of an electric vehicle charging transaction, the computer implemented method comprising:
>
> identifying, by a processor in the computer, an electric vehicle associated with a charging station and a set of principals associated with a charging transaction for the electric vehicle, wherein a principal in the set of principals is an entity having an interest in the charging transaction for the electric vehicle including an owner and an operator [sic] the electric vehicle and wherein the charging transaction is a transaction associated with at least one of charging the electric vehicle, storing electric power in an electric storage mechanism associated with the electric vehicle, and de-charging the electric vehicle;
>
> receiving charging transaction information, by the processor in the computer, wherein the charging transaction information comprises requirements, constraints, and preferences applicable to the charging transaction, wherein the preferences comprise at least one user-selected preference having a type specified as one of static, effective until an associated preference changes; dynamic, requiring user input of a value in real time; and temporary, effective for a predetermined period of time, with the preferences used to manage, govern, and control one or more aspects of the electric vehicle charging transaction so as to minimize, maximize, or optimize the aspects, and further the preferences are maintained in a vehicle preference service comprised of a software component for creating, managing, storing, requesting, updating, deleting, and retrieving the preferences according to the energy transaction plan;
>
> identifying, by the processor in the computer, a weighting value associated with each preference, wherein the weighting value indicates a priority of each preference relative to other preferences and determines an extent to which an associated preference is minimized, maximized, or optimized;

generating, by the processor in the computer, an energy transaction plan to control all aspects of the charging, discharging, and storing operations with the electric vehicle based on the charging transaction information, wherein the energy transaction plan comprises an identification of the electric vehicle, an identification of a principal in the set of principals to pay for the charging transaction, an identification of at least one electric power provider associated with the charging transaction, an owner of the charging station, charging transaction time driven event sequences that indicate the electric flow direction relative to the electric vehicle and rate of flow at each of a time mark and that specifies start and end times for the charging transaction and controls each of charging, discharging, and storing operations with the electric vehicle, and includes terms of the charging transaction to account for each of charging, discharging, and storing electric power, and further the energy transaction plan maximizes, minimizes, or optimizes each preference in accordance with the weighting value assigned to each preference, to control charging, discharging, and storing electric power; and

starting, conducting, and ending charging of the electric vehicle charging transaction using the processor in the computer configured to execute the generated energy transaction plan to control all aspects of the charging, discharging, and storing operations with the electric vehicle.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Pollack	US 2008/0039989 A1	Feb. 14, 2008

The following rejections are before us for review:

1. Claims 1–25 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

2. Claims 1–25 are rejected under 35 U.S.C. §102(e) as being anticipated by Pollack.

ISSUES

Did the Examiner err in rejecting claims 1–25 under 35 U.S.C. §101 as being directed to non-statutory subject matter?

Did the Examiner err in rejecting claims 1–25 under 35 U.S.C. §102(e) as being anticipated by Pollack?

ANALYSIS

The rejection of claims 1–25 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

As a preliminary matter, we observe that the statement of the rejection indicates that only claims 8–25 are being rejected. *See* Ans. 2. However, the body of the rejection mentions all the claims. Ans. 3. We assume the Examiner means to reject all the claims – a view the Appellants have also taken.

As a second matter, we do not consider the analysis put forward by the Examiner in the first instance as placing the Board in a position to perform a meaningful review of the rejection.

The Examiner determined that claims 1–25 are "deemed to claim an abstract idea (generating a plan)." Ans. 3. According to the Examiner, "generating an energy transaction plan based upon various attributes, including requirements, constraint and preferences, is a basic economic or administrative practice." Ans. 3. Apparently, because generating an energy transaction plan is a "basic" economic or administrative practice, it has been

"deemed" an abstract idea. That is not the law. The abstract idea judicially-excepted category of patent-ineligible subject matter applies to building blocks of human ingenuity, like fundamental economic practices, not "basic practice." "[I]n applying the §101 exception [laws of nature, natural phenomena, and abstract ideas], we must distinguish between patents that claim the "'buildin[g] block[s]'" of human ingenuity and those that integrate the building blocks into something more [*Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S.Ct. 1289 (2012)], thereby "transform[ing]" them into a patent-eligible invention [*Mayo*]." *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2354-55 (2014). For the rest, the Examiner states: "There are no meaningful limitations that transform the exception into a patent eligible application. The claims only manipulate abstract data elements. The generic computing elements recited are known and conventional." Ans. 3. There is no further analysis.

The Examiner's Answer, wherein the § 101 rejection was first presented, was mailed on Oct. 8, 2014. At that time, Examiners were instructed to formulate a rejection pursuant the "Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Ply. Ltd. v. CLS Bank International, et al.*," Memorandum, Andrew Hirshfeld, Deputy Commissioner for Patent Examination Policy, June 25, 2014. According to said memo, Examiners were to "[c]onsider the claim as a whole by considering all claim elements, both individually and in combination." That was not done here. Claim 1, for example, is replete with limitations, none of which are specifically treated. The Examiner's characterization of the claimed subject matter as "only manipulat[ing]

abstract data elements" (Ans. 3) is not a fair reading of what is claimed.

> Claim 1, for example, calls for
>
> starting, conducting, and ending charging of the electric vehicle charging transaction using the processor in the computer configured to execute the generated energy transaction plan to control all aspects of the charging, discharging, and storing operations with the electric vehicle.

This limitation expressly requires the "starting, conducting, and ending charging of the electric vehicle charging transaction" and the generated energy transaction plan is the software which the processor in the computer executes in order "to control all aspects of the charging, discharging, and storing operations with the electric vehicle." The characterization that the claim "only manipulates abstract data elements" (Ans. 3) fails to "[c]onsider the claim as a whole by considering all claim elements, both individually and in combination" as said then-existing guidance memo required Examiners to do. Nor does the analysis put forward by the Examiner in the first instance follow more recent guidance. More recent guidance has not changed the requirement to "[c]onsider the claim as a whole by considering all claim elements, both individually and in combination" *See* 2014 Interim Guidance on Patent Subject Matter Eligibility (Interim Eligibility Guidance), 79 FR 241 (Dec. 16, 2014) 74618-74633, 74624.

The Appellants argue that the rejection of claims 1–25 is improper because, *inter alia*, the invention provides a technical solution. (Reply Br. 7). In contrast to the paucity of explanation in support of the rejection, the Appellants have put forward a position that is comprehensive in explaining how claim limitations root the solution to the problem being solved in technology and thereby render the claim limitations as meaningful

limitations beyond simply employing a generic computer. Consistent with *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), the Appellants explain how "[t]he improvement over existing solutions in the field of electric vehicle charging is in the form of an energy transaction plan which is explicitly used to control aspects of the electric vehicle charging transaction." (Reply Br. 4); that is,

> [t]he energy transaction plan is a particular object which did not exist previously but is created by an implementation of the claimed method. The energy transaction plan is a synthesized object comprising particular elements including an identification of the electric vehicle, an identification of a principal in the set of principals to pay for the charging transaction, an identification of at least one electric power provider associated with the charging transaction, an owner of the charging station, charging transaction time driven event sequences that indicate the electric flow direction relative to the electric vehicle and rate of flow at each of a time mark and that specifies start and end times for the charging transaction. The energy transaction plan is accordingly a "logical controller" used to control each of charging, discharging, and storing operations with the electric vehicle, and includes terms of the charging transaction to account for each of charging, discharging, and storing electric power. The "controller" aspect of the energy transaction plan is accordingly used to maximize, minimize, or optimize each preference in accordance with the weighting value assigned to each preference, to control charging, discharging, and storing electric power. An implementation of the claimed method to produce the energy transaction plan effectively transforms the computer on which the method is implemented and the plan materialized into an electric power charging, discharging, and storing controller.

Reply Br. 6. The software-related language in the claims, as we have already pointed out for claim 1, reflects what the Appellants are arguing. *See Trading Technologies International v. CQG Inc.* (Fed. Cir., 2016-1616, 1/18/2017).

> For some computer-implemented methods, software may be essential to conduct the contemplated improvements. [*Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016)]("Much of the advancement made in computer technology consists of improvements to software that, by their very nature, may not be defined by particular physical features but rather by logical structures and processes."). Abstraction is avoided or overcome when a proposed new application or computer-implemented function is not simply the generalized use of a computer as a tool to conduct a known or obvious process, but instead is an improvement to the capability of the system as a whole.

Id. at 1336.

We find the Appellants' arguments persuasive as to error in the rejection and accordingly the rejection is reversed.

For the foregoing reasons, the rejection is not sustained.

The rejection of claims 1–25 under 35 U.S.C. §102(e) as being anticipated by Pollack.

As the Appellants point out, claim 1 requires

> identifying, by a processor in the computer, an electric vehicle associated with a charging station and a set of principals associated with a charging transaction for the electric vehicle, wherein a principal in the set of principals is an entity having an interest in the charging transaction for the electric vehicle including an owner and an operator [sic] the electric vehicle and wherein the charging transaction is a transaction associated with at least one of charging the electric vehicle, storing electric power in an electric storage mechanism associated with the electric vehicle, and de-charging the electric vehicle.

App. Br. 25.

The Examiner relies on paras. 52–60, 169, and 180 of Pollack as evidence that said limitations are expressly described in the prior art. *See* Ans. 4-5.

We have reviewed said Pollack disclosures. We agree with the Appellants that said claim limitation are not expressly described there. We do not see there any mention of "identifying [(a)] an electric vehicle associated with a charging station and [(b)] a set of principals associated with a charging transaction for the electric vehicle, wherein a principal in the set of principals is an entity having an interest in the charging transaction for the electric vehicle including an owner and an operator [of] the electric vehicle." Claim 1 (emphasis added). There is a mention of certain data sources and components that gather various types of information. *See* Pollack, paras.
61–62. But there is no mention of identifying an owner or an operator of the electric vehicle and therefore Pollack does not describe "a set of principals associated with a charging transaction for the electric vehicle, wherein a principal in the set of principals is an entity having an interest in the charging transaction for the electric vehicle including an owner and an operator [of] the electric vehicle" as claimed.

Said claim limitation is also not inherently described. While it is possible that Pollack could be made to identify the particular information claimed, "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Hansgirg v. Kemmer*, 102 F.2d 212, 214

(CCPA 1939), *quoted in Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

For the foregoing reasons, the §102 rejection of claim 1 and the claims dependent thereon is not sustained.

Said claim limitation discussed above is also present in the other independent claims – claims 8, 15, 18, and 22. Accordingly, the §102 rejection of these claims and the claims dependent thereon is also not sustained.

CONCLUSIONS

The rejection of claims 1–25 under 35 U.S.C. §101 as being directed to non-statutory subject matter is reversed.

The rejection of claims 1–25 under 35 U.S.C. §102(e) as being anticipated by Pollack is reversed.

DECISION

The decision of the Examiner to reject claims 1–25 is reversed.

REVERSED